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|--|---------------|----------------------|---------------------|------------------|
| APPLICATION NO.  | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/578,216   | 05/03/2006    | Kevin R. Lynch       | 198P00944USWO       | 7580             |
| 23322  | 7590          | 07/18/2008           | EXAMINER            |                  |
| IPLM GROUP, P.A.<br>POST OFFICE BOX 18455<br>MINNEAPOLIS, MN 55418 |               |                      | YOUNG, SHAWQUIA     |                  |
| ART UNIT   | PAPER NUMBER  |                      |                     |                  |
|  | 1626          |                      |                     |                  |
| MAIL DATE  | DELIVERY MODE |                      |                     |                  |
| 07/18/2008   | PAPER         |                      |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |
|------------------------------|--------------------------------------|-------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/578,216 | <b>Applicant(s)</b><br>LYNCH ET AL. |
|                              | <b>Examiner</b><br>SHAWQUIA YOUNG    | <b>Art Unit</b><br>1626             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 April 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11-16, 18, 22-33, 35 and 50-55 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 11-16, 18, 22-33, 35 and 50-55 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 03 May 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 4/15/08

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 11-16, 18, 22-33, 35 and 50-55 are currently pending in the instant application.

#### **I. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 15, 2008 is in partial compliance with the provisions of 37 CFR 1.97 because of missing English translations for Foreign patent documents and a missing copy of WO 01/71022. Accordingly, the information disclosure statement has been partially considered by the examiner.

#### **II. *Response to Arguments***

Applicants' amendment, filed April 15, 2008, has overcome the rejection of claims 11-16, 18, 22-33, 35 and 50-55 under 35 USC 112, second paragraph as being indefinite. The above rejection has been withdrawn.

The Examiner has attempted to search the genus compound in claim 50 as discussed with Applicants' attorney William Prout. However, the genus is too broad and the Examiner was unable to search the genus compound. The Examiner was able to search the genus compound disclosed in claim 11 and is willing to extend the scope of the elected invention to embrace the genus compound in claim 11 but not claim 50. The objection of the claims for containing non-elected subject matter will be maintained

and Applicants are suggested to amend the claims so that the subject matter is drawn to the genus found in claim 11.

**III. *Rejection(s)***

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-16, 18, 22-33, 35 and 50-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, in the definition of R<sub>7</sub> and R<sub>8</sub> are independently O, S, NR<sub>26</sub> or N. However, R<sub>8</sub> is a member of a ring system which has a double bond attached to it and a single bond attached to it within the ring. It is unlikely that R<sub>8</sub> could be NR<sub>26</sub> or O without a charge being present because in both cases the heteroatoms will have too many bonds attached to them. R<sub>7</sub> is a member of a ring system which there are two single bonds attached to it and it is unlikely that R<sub>7</sub> could be a N atom because it will not have enough bonds attached to it and would require another bond to be attached to the N atom. Appropriate correction is required.

**IV. *Objections***

*Claim Objection-Non Elected Subject Matter*

Claims 11-16, 18, 22-33, 35 and 50-55 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

**V. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626

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